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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,006	01/04/2002	Danette Andrea Dudley	5711-D1-01-MG	6483
28880	7590	09/28/2004	EXAMINER	
WARNER-LAMBERT COMPANY 2800 PLYMOUTH RD ANN ARBOR, MI 48105			RAYMOND, RICHARD L	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/038,006

Applicant(s)

DUDLEY ET AL.

Examiner

Richard L. Raymond

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 16-29, 31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 16-28, 31 and 32 is/are rejected.
- 7) ☒ Claim(s) 1, 2 and 29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>01/04/02; 05/19/03</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The Response of August 10, 2004 canceled claim 14. Accordingly, the claims now pending are claims 1-3, 16-29, 31 and 32.

### ***Election/Restrictions***

2. Pursuant to the further requirement for election of species, applicants have elected the compound: 3-(2-aminomethyl-phenyl)-1-[4-(2,4-dimethyl-piperidin-1-yl)-butyl]-1,3,4,5-tetrahydro-benzo[b][1,4]diazepin-2-one. Claims 1-3, 16-19, 31 and 32 are readable thereon.

### ***Improper Markush Rejection***

3. Claims 1, 16-28, 31 and 32 are rejected as being improper Markush claims in the definitions of the X<sub>1</sub>-X<sub>4</sub> ring members, and the B, D, E, G, J and K substituent groups. It is noted that the X<sub>1</sub>-X<sub>4</sub> ring members can be C or N, resulting in structurally diverse ring systems (containing phenyl, pyridinyl, piperidinyl, 1,2-, 1,3- and 1,4 diazinyl, triazinyl and tetrazinyl rings fused to 7- and 8-membered diazo rings) which themselves can be unsubstituted (all ring substituents B, D, E, G, J, K and L can be H). The resulting total compounds lack a common core and are structurally diverse and patentably distinct one from the others. A reference anticipating one under 35 USC 102 would not be a reference against the others under 35 USC 103. Limitation of the claims

to compounds where the X<sub>1</sub>-X<sub>4</sub> ring members are all carbon, A is NCH<sub>2</sub> and the deleted N(alkyl)CH<sub>2</sub>, CH<sub>2</sub>N and CH<sub>2</sub>N(alkyl) groups, and B and D correspond to R<sub>7</sub>, E is O, and G-J-K corresponds to X-Y, encompassing the elected species, will overcome this rejection. See the scope of the corresponding six-membered compounds in the parent patent (6,410,536). With respect to the ring substituents, note that the unsubstituted and simple substituted ring systems are known in the art. See the two cited Chemical Abstracts references, for example.

***Allowable Subject Matter***

4. Claims 2, 3 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, or upon allowance of a claim generic thereto.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Raymond whose telephone number is (571) 272-0673.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on (571) 272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard L. Raymond  
Primary Examiner  
Art Unit 1624

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September 27, 2004